

CHUCK P. EBERTIN (SBN 161374)  
cebertin@velaw.com  
VINSON & ELKINS LLP  
1841 Page Mill Road, Suite 200-B  
Palo Alto, CA 94304  
Tel: (650) 687-8200 / Fax: (650) 618-1970

CHRISTOPHER V. RYAN (*pro hac vice*)  
cryan@velaw.com  
EFREN GARCIA (*pro hac vice*)  
egarcia@velaw.com  
JANICE L. TA (*pro hac vice*)  
jta@velaw.com  
VINSON & ELKINS LLP  
The Terrace 7  
2801 Via Fortuna, Suite 100  
Austin, TX 78746  
Tel: (512) 542-8400 / Fax: (512) 542-8612

DAVID J. TOBIN (*pro hac vice*)  
dtobin@velaw.com  
VINSON & ELKINS LLP  
2001 Ross Avenue, Suite 3700  
Dallas, TX 75201  
Tel: (214) 220-7949 / Fax (214) 999-7949

Attorneys for Plaintiff and Counterclaim  
Defendant SANDISK CORPORATION

**UNITED STATES DISTRICT COURT**  
**NORTHERN DISTRICT OF CALIFORNIA**  
**SAN FRANCISCO**

SANDISK CORPORATION,  
  
Plaintiff and Counterclaim Defendant,  
  
vs.  
  
ROUND ROCK RESEARCH LLC,  
  
Defendant and Counterclaim Plaintiff.

Case No. 3:11-cv-05243-RS

**SANDISK'S NOTICE OF MOTION,  
MOTION, AND MEMORANDUM IN  
SUPPORT OF ITS MOTION TO  
STRIKE PORTIONS OF ROUND  
ROCK'S EXPERT REPORTS**

Date: February 13, 2014  
Time: 1:30 p.m.  
Judge: Hon. Richard Seeborg

**REDACTED PUBLIC VERSION**

# TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION .....	1
A. By Adding New Products, Round Rock's Experts Magnify By 3300-Fold the Royalty Base for the '345 Patent .....	2
B. Round Rock's Experts Add New Products for the '053 Patent .....	3
C. Round Rock's Experts Introduce Indirect Infringement Theories For Each of the Patents .....	4
II. ARGUMENT .....	4
A. Legal Background .....	4
1. The Patent Local Rules require a specific identification of accused products, and the remedy for non-compliance includes striking expert reports. ....	5
2. The Patent Local Rules do not allow for boilerplate allegations of indirect infringement.....	5
B. Portions of the Zeidman and Wagner Reports Should Be Stricken For Accusing Products That Were Not Identified In the '345 Patent Infringement Contentions .....	6
1. Round Rock's '345 Patent infringement contentions identify only those products compliant with the mDOC H3 datasheet. ....	6
2. Round Rock's experts accuse products that are not compliant with the mDOC datasheet. ....	7
3. Round Rock's addition of accused products in its expert reports is inexcusable.....	8
C. Portions of the Zeidman and Wagner Reports Should Be Stricken For Accusing Products That Were Not Identified In the '053 Patent Infringement Contentions .....	10
1. Round Rock's experts accuse unidentified products of infringing the '053 patent. ....	10
2. Round Rock's delay in accusing products is inexcusable. ....	11
D. Portions of the Zeidman and Afromowitz Reports Should Be Stricken For Describing Indirect Infringement Theories for the '345, '053, '791, and '839 Patents .....	12
1. Round Rock's infringement contentions provided boilerplate assertions of inducement and contributory infringement.....	12

1	2.	Round Rock’s experts describe indirect infringement theories for the first time. ....	14
2			
3	3.	Round Rock’s disclosure of its theories for the first time in expert reports is inexcusable. ....	15
4	III.	CONCLUSION.....	16
5			
6			
7			
8			
9			
10			
11			
12			
13			
14			
15			
16			
17			
18			
19			
20			
21			
22			
23			
24			
25			
26			
27			
28			

## TABLE OF AUTHORITIES

Page(s)**Cases**

<i>Bender v. Maxim Integrated Prods., Inc.</i> , No. C 09-01152 SI, 2010 WL 2991257 (N.D. Cal. July 29, 2010) .....	6, 8, 14
<i>Creagri, Inc. v. Pinnacle Life, Inc.</i> , No. 11-cv-06635-LHK-PSG, 2012 WL 5389775 (N.D. Cal. Nov. 2, 2012) .....	14
<i>France Telecom, S.A. v. Marvell Semiconductor, Inc.</i> , No. 12-cv-04967 WHA (NC), 2013 WL 1878912 (N.D. Cal. May 3, 2013) .....	5, 6, 14
<i>Infineon Techs. AG v. Volterra Semiconductor Cop.</i> , No. C 11-6239 MMC (DMR), 2012 WL 6184394 (N.D. Cal. Dec. 11, 2012) .....	5, 8
<i>Mediatek, Inc. v. Freescale Semiconductor, Inc.</i> , No. 11-5341 YGR (JSC), 2013 WL 588760 (N.D. Cal. Feb. 13, 2013) .....	<i>passim</i>
<i>Monolithic Power Sys. v. O2 Micro Int'l Ltd.</i> , No. C 08-04567 CW, 2009 WL 3353306 (N.D. Cal. Oct. 16, 2009) .....	5, 10, 12
<i>Oracle Am. v. Google Inc.</i> , No. C 10-03561 WHA, 2011 WL 4479305 (N.D. Cal. Sep. 26, 2011) .....	2, 5, 8, 12

**Other Authorities**

35 U.S.C. § 271 .....	13
-----------------------	----

**Rules**

Patent L.R. 3-1 .....	5, 6
Patent L.R. 3-1(c) .....	6, 7
Patent L.R. 3-1(d) .....	12

**NOTICE OF MOTION AND MOTION**

TO ALL PARTIES AND THEIR ATTORNEYS OF RECORD:

PLEASE TAKE NOTICE THAT on February 13, 2014 (or as soon thereafter as the Court's schedule permits), before The Honorable Richard G. Seeborg of the United States District Court for the Northern District of California, located at Courtroom 3, 450 Golden Gate Avenue, 17th Floor, San Francisco, California, 94102, plaintiff SanDisk Corporation ("SanDisk") will, and hereby does, move for an Order striking portions of the opening reports of the expert witnesses hired by defendant Round Rock Research LLC ("Round Rock"), including the technical expert report of Bob Zeidman ("Zeidman Report," Ex. 1), the damages expert report of Michael Wagner ("Wagner Report," Ex. 2), and the technical expert report of Martin Afromowitz ("Afromowitz Report," Ex. 3). This motion is based on this Notice of Motion and Motion, the following memorandum, the Declaration of Chuck Ebertin ("Ebertin Decl."),<sup>1</sup> the pleadings and papers on file herein, any oral argument before the Court, and any other matters the Court may request or consider.

**I. INTRODUCTION**

During fact discovery in this case, Round Rock served three iterations of infringement contentions in which it accused certain SanDisk products of infringement and made boilerplate assertions about indirect infringement. SanDisk relied upon Round Rock's infringement contentions to guide it through discovery, because the duty to provide infringement contentions required Round Rock "to crystallize its theories of the case early in the litigation and to adhere to those theories once disclosed." *See Mediatek, Inc. v. Freescale Semiconductor, Inc.*, No. 11-5341 YGR (JSC), 2013 WL 588760, at \*1 (N.D. Cal. Feb. 13, 2013) (Corley, M.J.). Infringement contentions were crucial to SanDisk focusing its case preparation, given that Round Rock's contentions asserted infringement of twelve patents, which now have been whittled down to seven.<sup>2</sup>

<sup>1</sup> The exhibits cited herein refer to those attached to the Declaration of Chuck Ebertin.

<sup>2</sup> Round Rock has dismissed five patents with prejudice. [*See* Dkt. No. 101 (July 19, 2013, dropping two patents), Dkt. No. 114 (Dec. 13, 2012, dropping one patent), Dkt. No. 251 (Dec. 4, 2013, dropping two patents).] SanDisk expects Round Rock to drop an additional three patents relating to fabrication of semiconductor devices, because Zeidman and Afromowitz offered no opinions concerning infringement of those patents and Wagner did not consider those patents in his damages calculations.

After the close of fact discovery though, Round Rock identified in its expert reports new accused products that had not been identified in any of its infringement contentions and described alleged acts of indirect infringement that had never been disclosed in its three versions of infringement contentions. Infringement contentions must fully and specifically disclose the accused products and a patentee's theories of infringement, and the patentee cannot introduce new matter for the first time in its expert reports. *See Oracle Am. v. Google Inc.*, No. C 10-03561 WHA, 2011 WL 4479305, at \*2 (N.D. Cal. Sep. 26, 2011) (striking expert report reports as to products that "were not among the products specifically identified in Oracle's disclosure of accused products, Oracle may not now accuse them of infringement"). Accordingly, SanDisk respectfully requests that the Court strike those portions of Round Rock's expert reports that relate to accused products and alleged acts of indirect infringement that were not specifically disclosed in its infringement contentions.

**A. By Adding New Products, Round Rock's Experts Magnify By 3300-Fold the Royalty Base for the '345 Patent**

The portions of the Zeidman and Wagner Reports that concern products accused of infringing U.S. Pat. No. 5,682,345 ("the '345 patent") *other than* SanDisk's mDOC product line should be stricken because those products were not properly disclosed in Round Rock's infringement contentions. Round Rock's infringement contentions for the '345 patent specifically accused "SanDisk products that comply with the mDOC H3 datasheet, revisions 1.2 Nov. 2007) & 1.3 (May 2008)"; identified several specific stock keeping units ("SKUs"), all associated with the mDOC product line, as examples of products that comply with the mDOC H3 datasheet; and included a single "claim chart [that] applies to SanDisk products that comply with the mDOC H3 datasheet." [Ex. 4 (Am. Infringement Contentions, dated June 29, 2012) at 3:7-16 & Ex. B.] Accordingly, Round Rock led SanDisk to believe that the scope of the '345 patent case was limited to "SanDisk products that comply with the mDOC H3 datasheet."

Nonetheless, Round Rock's experts now assert infringement of entirely separate SanDisk product lines (including iNAND, SD cards, and microSD cards), even though none of these product lines comply with the mDOC H3 datasheet. [See Ex. 1 (Zeidman Report) at 42 ¶ 111; *see also* Ex. 2 (Wagner Report) at 130 ¶ 441.]

1 Round Rock's delay in accusing these products until this late date is inexcusable, because  
2 Round Rock received discovery relating to these products in July 2012—almost one year before  
3 Round Rock served its third set of infringement contentions [*See* Dkt. No. 186 (Mot. for Leave to  
4 Am. Infringement Contentions, filed July 3, 2013)] and more than 17 months before Round Rock  
5 served expert reports. Indeed, Round Rock's experts rely on these very documents to support their  
6 new opinions. By accusing products not identified in the infringement contentions—those that do  
7 not comply with the mDOC H3 datasheet—Round Rock's experts explode the scope of the '345  
8 patent case [REDACTED]

9 [REDACTED]  
10 [REDACTED]  
11 [REDACTED]  
12 [REDACTED]  
13 [REDACTED]  
14 [REDACTED]  
15 [REDACTED]  
16 [REDACTED]  
17 [REDACTED]

18 [Ex. 2 at Schedule 12.0 (excerpted).]

19 **B. Round Rock's Experts Add New Products for the '053 Patent**

20 The portions of the Zeidman and Wagner Reports that relate to alleged infringement of U.S.  
21 Pat. No. 6,845,053 ("the '053 patent") by SanDisk products whose SKUs begin with SDIN7 or  
22 SDIN8 should be stricken because those products were not disclosed in Round Rock's infringement  
23 contentions. Round Rock's experts assert infringement of the '053 patent against products whose  
24 SKU begins with the prefix SDIN7 and SDIN8 based on documents SanDisk produced in November  
25 2012. [*See* Ex. 1 (Zeidman Report) at 37–38 ¶ 102, 44 ¶ 116 (referring to "SDIN7XX" and  
26 "SDIN8XX").] Indeed, in July 2013, Round Rock sought leave to amend its infringement  
27 contentions for the '053 patent to add other products [*see* Dkt. No. 186], but chose not to identify  
28

any SDIN7XX or SDIN8XX products in its amended contentions. Round Rock's accusation of these products for the first time in its expert reports is inexcusable.

**C. Round Rock's Experts Introduce Indirect Infringement Theories For Each of the Patents**

The portions of the Zeidman and Afromowitz Reports that describe alleged acts of indirect infringement of the '345 and '053 patents, and U.S. Pat. Nos. 6,570,791 ("the '791 patent") and 6,383,839 ("the '839 Patent") should be stricken because Round Rock's infringement contentions did not disclose any such acts. Round Rock's infringement contentions provided boilerplate recitations of inducement and contributory infringement theories, as opposed to the particular allegations required by Patent Local Rule 3-1(d). SanDisk complained multiple times to Round Rock about the lack of particularized allegations, to no avail. Instead, Round Rock chose to wait until its expert reports to disclose for the first time any specific allegations of indirect infringement. [See Ex. 1 § IV.H.2; Ex. 3. § IV.E.4.] Round Rock's failure to provide its indirect infringement theories during fact discovery is inexcusable because Round Rock had SanDisk's sales data long before fact discovery closed.

**II. ARGUMENT**

**A. Legal Background**

"The overriding principle of the Patent Local Rules is that they are designed to make the parties more efficient, to streamline the litigation process, and to articulate with specificity the claims and theory of a plaintiff's infringement claims." See *Mediatek*, 2013 WL 588760, at \*1 (internal citations and quotations omitted). The Patent Local Rules are not optional, but instead require that infringement contentions "shall contain the following information:"

(b) Separately for each asserted claim, each accused apparatus, product, device, process, method, act, or other instrumentality ("Accused Instrumentality") of each opposing party of which the party is aware. ***This identification shall be as specific as possible. Each product, device, and apparatus shall be identified by name or model number, if known.*** Each method or process shall be identified by name, if known, or by any product, device, or apparatus which, when used, allegedly results in the practice of the claimed method or process;

(c) ***A chart identifying specifically where each limitation of each asserted claim is found within each Accused Instrumentality . . . .***



(d) For each claim which is alleged to have been indirectly infringed, *an identification of any direct infringement and a description of the acts of the alleged indirect infringer that contribute to or are inducing that direct infringement*. Insofar as alleged direct infringement is based on joint acts of multiple parties, the role of each such party in the direct infringement must be described.

Patent L.R. 3-1 (emphasis added).

1. The Patent Local Rules require a specific identification of accused products, and the remedy for non-compliance includes striking expert reports.

This Court has interpreted Patent Local Rule 3-1 to require a “*specific* identification of particular accused products.” *Mediatek*, 2013 WL 588760 at \*1 (emphasis in original) (quoting *Oracle Am. v. Google Inc.*, No. C 10–03561 WHA, 2011 WL 4479305, at \*2 (N.D. Cal. Sep. 26, 2011)). Patent Local Rule 3-1 “does ‘not tolerate broad categorical identifications’ or ‘the use of mere representative examples.’” *Id.* at \*1 (quoting *Infineon Techs. AG v. Volterra Semiconductor Cop.*, No. C 11-6239 MMC (DMR), 2012 WL 6184394, at \*3 (N.D. Cal. Dec. 11, 2012)). “Representative examples may be a useful tool for proving an infringement case at trial, but a full list of accused products must be disclosed as part of a party’s infringement contentions.” *Oracle*, 2011 WL 4479305, at \*2.

When an expert report accuses products that were not specifically identified in infringement contentions, the remedy is to strike those newly added products from the expert report. *See id.* at \*3 (granting a motion to strike portions of an expert report accusing products that “were not among the products specifically identified” in the infringement contentions); *Monolithic Power Sys. v. O2 Micro Int’l Ltd.*, No. C 08-04567 CW, 2009 WL 3353306, at \*3 (N.D. Cal. Oct. 16, 2009) (same).

2. The Patent Local Rules do not allow for boilerplate allegations of indirect infringement.

Neither “[b]oilerplate language of indirect infringement [nor a] bare-boned recitation of the essential elements of a claim for indirect infringement” satisfy Patent Local Rule 3-1(d); rather, “Rule 3-1(d) requires facts.” *France Telecom, S.A. v. Marvell Semiconductor, Inc.*, No. 12-cv-04967 WHA (NC), 2013 WL 1878912, at \*5 (N.D. Cal. May 3, 2013). In particular, Patent Local Rule 3-1(d) requires “a *description of the acts* of the alleged indirect infringer [and] the role of each party

1 must be *described*.” *Id.* (emphasis in original); *see also Bender v. Maxim Integrated Prods., Inc.*,  
 2 No. C 09-01152 SI, 2010 WL 2991257, at \*4 (N.D. Cal. July 29, 2010) (requiring the plaintiff to  
 3 “identify how any third party was engaging in acts of direct infringement and how [the defendant]  
 4 was allegedly contributing to that direct infringement.”)

5 **B. Portions of the Zeidman and Wagner Reports Should Be Stricken For Accusing**  
 6 **Products That Were Not Identified In the ’345 Patent Infringement Contentions**

- 7 1. Round Rock’s ’345 Patent infringement contentions identify only those  
 8 products compliant with the mDOC H3 datasheet.

9 Round Rock failed to comply with Patent Local Rule 3-1(b) and (c) by accusing products in  
 10 its expert reports that were not disclosed in the infringement contentions. On May 4, 2012, Round  
 11 Rock served its initial infringement contentions, which accused “SanDisk microSD memory cards  
 12 and iNAND eMMC EFDs” as infringing the ’345 Patent. [See Ex. 5 (Orig. Infringement  
 13 Contentions, dated 5/4/2012).] Notably, the accompanying charts only included an analysis of  
 14 “SanDisk’s mDOC H3 Embedded Flash Drive,” which was performed by mapping the ’345 Patent  
 15 claims against the “SanDisk mDOC H3 Embedded Flash Drive, Data Sheet Rev 1.2, Nov. 2007.”  
 16 See Patent L.R. 3-1(c) (requiring a “chart identifying specifically where each limitation of each  
 17 asserted claim is found within *each* Accused Instrumentality” (emphasis added)).

18 Round Rock subsequently amended its infringement contentions, clarifying that Round Rock  
 19 was asserting infringement of the ’345 Patent only against those products that comply with the  
 20 mDOC H3 datasheet:

21 *SanDisk products that comply with the mDOC H3 datasheet, revisions 1.2 (Nov.*  
 22 *2007) & 1.3 (May 2008)*, such as microSD memory cards and mDOC H3 embedded  
 23 flash drives (“EFDs”), including without limitation model numbers MDxx-xx and  
 24 SDEDx-x, such as MD2534-d1GX-P, MD2534-d1G-X-P/Y, MD2534-d2G-X-P,  
 25 MD2534-d2G-X-P/Y, SDED7-256M-N9T, SDED7-256M-N9Y, SDED7-512M-NAT,  
 26 SDED7-512M-NAY, SDED7-001GNT, SDED7-002G-NT, MD2533-d8G-X-P,  
 27 MD2533-d8GX-P/Y, SDED5-001G-NAT, SDED5-001G-NAY, MD2533-d16G-X-P,  
 28 MD2533-d16G-X-P/Y, SDED5-002GNC, SDED5-002G-NCT, SDED5-002G-NCY,  
 SDED5-004G-NC, SDED5-004G-NCT, SDED5-004G-NCY, SDED5-008G-NC,  
 SDED5-008G-NCT, and SDED5-008GNCY.

1 [See Ex. 4 (Am. Infringement Contentions) at 3:7–16 & Ex. B (emphasis added).] [REDACTED]

2 [REDACTED]  
3 [REDACTED] See Patent L.R. 3-1(b) (requiring that the “identification shall be as specific as  
4 possible. Each product, device, and apparatus shall be identified by name or model number, if  
5 known.”).

6 Round Rock’s infringement contentions also provided a single claim chart that mapped the  
7 asserted claims of the ’345 Patent against the “mDOC H3 datasheet, revisions 1.2 (Nov. 2007) & 1.3  
8 (May 2008).” [Id.] See Patent L.R. 3-1(c) (requiring a “chart identifying specifically where each  
9 limitation of each asserted claim is found within each Accused Instrumentality”).

10 2. Round Rock’s experts accuse products that are not compliant with the mDOC  
11 datasheet.

12 Despite Round Rock’s infringement contentions, Round Rock’s experts accuse product lines  
13 that do not “comply with the mDOC H3 datasheet,” [REDACTED]

14 [REDACTED]  
15 [REDACTED]  
16 [REDACTED]  
17 [REDACTED]  
18 [REDACTED]  
19 [REDACTED]  
20 Round Rock never identified the iNAND and SD products in its infringement contentions as  
21 infringing the ’345 patent. Regarding the microSD product line, Round Rock’s infringement  
22 contentions did not identify any specific model numbers or include any claim chart comparing any  
23 ’345 patent claims against even a single microSD product; rather, its contentions only identified  
24 microSD products to the extent such products are examples of “SanDisk products that comply with  
25 the mDOC H3 datasheet.” [See Ex. 4 at 3:7–9 (“SanDisk products that comply with the mDOC H3  
26 datasheet, revisions 1.2 (Nov. 2007) & 1.3 (May 2008), *such as* microSD memory cards and mDOC  
27 H3 embedded flash drives (“EFDs”) . . .”) (emphasis added).] Accordingly, under Patent Local  
28 Rules 3-1(b) and 3-1(c), the only products Round Rock should be permitted to address in its expert

1 reports are “SanDisk products that comply with the mDOC H3 datasheet.” *See Mediatek*, 2013 WL  
2 588760 at \*1 (interpreting Patent Local Rule 3-1 to require a “*specific* identification of particular  
3 accused products” (emphasis in original)).

4 Round Rock and its experts now seek to bypass the Patent Local Rules by asserting that even  
5 though the iNAND, microSD, and SD products do not comply with the mDOC H3 datasheet, they  
6 nonetheless infringe because they “contain the same general controller structure” as those products  
7 which do comply with the mDOC H3 datasheet. [Ex. 1 (Zeidman Report) at 42 ¶ 111.] However,  
8 the “merits of this theory are irrelevant to the question of whether [Round Rock’s] disclosures  
9 adequately supported the infringement accusations in the [expert] report.” *Oracle*, 2011 WL  
10 4479305, at \*2. Round Rock never set forth this theory in its infringement contentions. Further,  
11 Round Rock is wrong on the merits because the mDOC products are from a completely separate  
12 product line than the microSD, SD, and iNAND products.<sup>3</sup> Patent Local Rule 3-1 “required *specific*  
13 identification of particular accused products. They did not tolerate broad categorical identifications .  
14 . . . nor did they permit the use of mere representative examples.” *Id.*; *see also Bender*, 2010 WL  
15 1689465, at \*3 (finding infringement contentions inadequate for failing “to articulate how the  
16 accused products share the same, or substantially the same, infringing circuitry with any other  
17 product or with the . . . ‘representative products.’”).

18 3. Round Rock’s addition of accused products in its expert reports is  
19 inexcusable.

20 Round Rock cannot argue that it did not know about SanDisk’s other product lines when it  
21 served its infringement contentions. *See Infineon*, 2012 WL 6184394 at \*3 (explaining “narrow  
22 exceptions to this specific identification requirement, *inter alia*, if the plaintiff does not know of the  
23 allegedly infringing product when it serves its infringement contentions and could not have

24  
25 <sup>3</sup>



1 discovered the product absent discovery”). Long before the close of fact discovery, SanDisk  
2 produced documents to Round Rock with information relating to the structure of controllers used in  
3 iNAND, microSD, and SD products. For example, in July 2012, SanDisk produced spreadsheets  
4 correlating the flash memory controllers used with various products, including microSD, iNAND  
5 and SD products. [See generally Ex. 6 (SanDisk’s 1<sup>st</sup> Supp’l Resp. to Interrog. No. 1).] [REDACTED]

6 [REDACTED]  
7 [REDACTED]  
8 [REDACTED]  
9 [REDACTED] That same day, SanDisk produced technical  
10 documents describing the functionality of flash memory controllers for SanDisk’s products,  
11 including iNAND, microSD and SD products. [See, e.g., Ex. 7 (letter enclosing Patent L.R. 3-4(b)  
12 production of documents, including Bates numbers SAN00000001–13625).] In October 2012,  
13 SanDisk explicitly informed Round Rock that [REDACTED]

14 [REDACTED]  
15 [REDACTED]  
16 [REDACTED]  
17 [REDACTED]  
18 [REDACTED]  
19 [REDACTED]  
20 [REDACTED]

21 [REDACTED]  
22 [REDACTED]  
23 [REDACTED]  
24 From interrogatory responses and documents served by SanDisk at least one year before  
25 close of fact discovery, Round Rock was put on notice that the accused mDOC Products using the  
26 [REDACTED] are the only products that “comply with the mDOC H3 datasheet.” Those  
27 documents also supplied Round Rock with sufficient technical information about the controllers  
28

1 used in SanDisk's microSD, SD, and iNAND products for Round Rock to decide whether to include  
 2 such products in its infringement contentions for the '345 Patent. Nonetheless, Round Rock chose  
 3 not to amend its infringement contentions, and instead chose to accuse products for the first time  
 4 after the close of discovery via its expert reports.

5 Accordingly SanDisk requests that with respect to the '345 patent, the infringement assertions  
 6 of Zeidman and royalty base of Wagner be limited to those products identified in Round Rock's  
 7 infringement contentions—"SanDisk products that comply with the mDOC H3 datasheet, revisions 1.2  
 8 (Nov. 2007) & 1.3 (May 2008)"—and that Round Rock's experts be precluded from asserting  
 9 infringement of the '345 patent by SanDisk's SD, microSD, and iNAND product lines. *See Oracle*,  
 10 2011 WL 4479305, at \*3 (granting motion to strike portions of an expert report relating to products not  
 11 identified in the infringement contentions); *Monolithic Power*, 2009 WL 3353306, at \*3.

12 **C. Portions of the Zeidman and Wagner Reports Should Be Stricken For Accusing**  
 13 **Products That Were Not Identified In the '053 Patent Infringement Contentions**

14 1. Round Rock's experts accuse unidentified products of infringing the '053  
 15 patent.

16 Round Rock failed to comply with Patent Local Rules 3-1(b) and (c) by accusing products in  
 17 its expert reports that were not disclosed in the '053 patent infringement contentions. Round Rock's  
 18 infringement contentions, served on June 29, 2012, identified the following model numbers (SKUs)  
 19 as infringing the '053 patent:

20 SanDisk products compliant with JEDEC Standard JESD84-A441, such as SanDisk  
 21 iNAND eMMC EFDs, including without limitation model numbers SDINxxx-x, such  
 22 as SDIN2C1-2G, SDIN4C1-4G, SDIN4C1-8G, SDIN5B2-8G, SDIN5B2-16G,  
 23 SDIN5B2-32G, SDIN5B2-32G-E, SDIN5B2-64G, SDIN5C1-4G, SDIN5C1-4G-E,  
 24 SDIN5C1-8G, SDIN5C1-8G-E, SDIN5C1-8G-L, SDIN5C1-8G-T, SDIN5C1-16G,  
 25 SDIN5C1-16G-L, SDIN5C1-32G, SDIN5C1-32G-L, SDIN5C1-64G-L, SDIN5C2-  
 26 4G, SDIN5C2-4G-E, SDIN5C2-4G-T, SDIN5C2-8G, SDIN5C2-8G-E, SDIN5C2-  
 27 8G-L, SDIN5C2-8G-LE, SDIN5C2-8G-T, SDIN5C2-16G, SDIN5C2-16G-E,  
 28 SDIN5C2-16G-L, SDIN5C2-16G-LE, SDIN5C2-16G-LT, SDIN5C2-32G,  
 SDIN5C2-32G-L, SDIN5C2-32G-LE, SDIN5C2-64G, SDIN5C2-64G-L, SDIN5C2-  
 8G-L, SDIN5C4-8G, SDIN5C4-16G, SDIN5C4-32G, SDIN5C4-64G, SDIN5D1-2G,  
 SDIN5D1-2G-L, SDIN5D1-2G-LE, SDIN5D1-4G, SDIN5D1-4G-L, SDIN5D1-4G-  
 LE, SDIN5D1-8G-L, SDIN5D2-2G, SDIN5D2-4G, SDIN5D2-4G-L, SDIN5D2-4G-  
 LE, SDIN5D2-8G-L, SDIN5D2-8G-LE, SDIN5D2-16G-L, SDIN5E1-32G,  
 SDIN5E1-32G-E, SDIN5F1-64G, SDIN5F2-64G.

[See Ex. 4 at 8:3–16 & Ex. L.] Unfettered by the infringement contentions, Round Rock’s experts now assert that products whose SKU begins with the prefix SDIN7 and SDIN8 infringe the ’053 patent. [Ex. 1 (Zeidman Report) at 37–38 ¶ 102, 44 ¶ 116 (referring to “SDIN7XX” and “SDIN8XX”).] However, Round Rock did not identify the SDIN7XX and SDIN8XX products in its infringement contentions for the ’053 patent. *See Mediatek*, 2013 WL 588760 at \*1 (interpreting Patent Local Rule 3-1 to require a “*specific* identification of particular accused products [and that Rule 3-1 does] ‘not tolerate broad categorical identifications’ or ‘the use of mere representative examples’” (emphasis in original)).

2. Round Rock’s delay in accusing products is inexcusable.

Eleven months before the close of fact discovery, Round Rock had the information it needed to specifically identify the SDIN7XX and SDIN8XX products in its infringement contentions. The very document that Zeidman relies on to support his infringement assertions for the SDIN7XX and SDIN8XX products was produced over one year ago, on Nov. 12, 2012. [*Compare* Ex. 1 (Zeidman Report) at 38 ¶ 102, 44 ¶ 116 (relying on SAN00017921 and 17924) *with* Ex. 9 (Lett. enclosing production with Bates range SAN00017848–17959, dated Nov. 12, 2012).] Thus, the materials needed by Round Rock to assert infringement of the ’053 patent against the SDIN7XX and SDIN8XX products were readily available to Round Rock long before it served its expert reports.

Round Rock’s decision to wait until its expert reports is particularly egregious because Round Rock sought leave in July 2013 to amend its infringement contentions to accuse additional products of infringing the ’053 patent. [*See* Dkt. No. 186.] Nine months before it sought leave to amend its contentions for the ’053 patent, Round Rock possessed the document that allegedly supports its infringement claims against the SDIN7XX and SDIN8XX products, yet Round Rock chose not to include the SDIN7XX and SDIN8XX products among the new products it was adding to its infringement contentions. Accordingly SanDisk requests that with respect to the ’053 patent, Round Rock’s experts be limited to asserting infringement based only upon those products identified in Round Rock’s infringement contentions and be precluded from asserting infringement based upon the SDIN7XX and SDIN8XX products. *See Mediatek*, 2013 WL 588760 at \*1 (interpreting Patent Local Rule 3-1 to require a “*specific* identification of particular accused products” (emphasis in



original)); *Oracle*, 2011 WL 4479305, at \*3 (granting motion to strike portions of an expert report relating to products not identified in the infringement contentions); *Monolithic Power*, 2009 WL 3353306, at \*3 (same).

**D. Portions of the Zeidman and Afromowitz Reports Should Be Stricken For Describing Indirect Infringement Theories for the '345, '053, '791, and '839 Patents**

1. Round Rock's infringement contentions provided boilerplate assertions of inducement and contributory infringement.

Round Rock failed to comply with Patent Local Rule 3-1(d) when it described particularized inducement and contributory infringement theories for the first time in its expert reports with respect to the '345, '053, '791, and '893 Patents. Round Rock's infringement contentions provided boilerplate assertions of inducement:

SanDisk has induced infringement by third parties, including SanDisk's customers, and continues to induce such infringement, under 35 U.S.C. § 271(b), of at least claims 1, 24, and 39 of the '345 patent. These third parties infringe these claims under 35 U.S.C. § 271(a) by making, using, selling, and/or offering for sale in the United States, and/or importing into the United States, the '345 Accused Products. For example, SanDisk actively, knowingly, and intentionally induced, and continues to actively, knowingly, and intentionally induce, infringement of the '345 patent by selling or otherwise supplying the '345 Accused Products; with the knowledge and intent that these third parties will use, sell, and/or offer for sale in the United States, and/or import into the United States, the '345 Accused Products to infringe the '345 patent; and with the knowledge and intent to encourage and facilitate the infringement through the dissemination of the '345 Accused Products and the creation and dissemination of promotional and marketing materials, supporting materials, instructions, product manuals, and/or technical information related to the '345 Accused Products.

[Ex. 4 at Ex. B ('345 patent) pp. 1-2.] Round Rock provided nearly identical assertions regarding the other asserted patents. [See Ex. 4 at Ex. G ('893 patent), Ex. H ('791 patent), Ex. L ('053 patent).] Round Rock's contributory infringement allegations fared no better, merely reciting the elements of the cause of action but providing no disclosure as to its theories of contributory infringement:

SanDisk has contributed to the infringement by third parties, including SanDisk's customers, and continues to contribute to infringement by third parties, under 35 U.S.C. § 271(c), of at least claims 1, 24, and 39 of the '345 patent. These third parties infringe these claims under 35 U.S.C. § 271(a) by making, using, selling, and/or offering for sale in the United States, and/or importing into the United States, the '345



1 Accused Products. For example, SanDisk sells and/or offers for sale in the United  
2 States, and/or imports into the United States, the '345 Accused Products, knowing  
3 that those products constitute a material part of the inventions of the '345 patent,  
4 knowing that those products are especially made or adapted to infringe the '345  
patent, and knowing that those products are not staple articles of commerce suitable  
for substantial noninfringing use.

5 [See, e.g., *id.* at Ex. B ('345 patent) p. 2.] Other than reciting boilerplate allegations, Round Rock's  
6 allegations of indirect infringement failed to describe: (a) how any of the unnamed direct infringers  
7 were allegedly infringing the patents (e.g., whether by selling, importing, etc.); (b) how SanDisk  
8 allegedly induced or contributed to the direct infringement; (c) how SanDisk's products are  
9 especially made or adapted to infringe the patents; (d) what other products must be combined with  
10 SanDisk's products in order to infringe the patents; and (e) why SanDisk's products are not staple  
11 articles of commerce.

12 Round Rock's infringement contentions did not identify how any of the unnamed direct  
13 infringers were allegedly infringing the asserted patents. Instead, Round Rock just parroted the  
14 language of 35 U.S.C. § 271(a)—“by making, using, selling, and/or offering for sale in the United  
15 States, and/or importing into the United States.” [*E.g., id.* at Ex. B pp. 1–2.] This is in violation of  
16 Local Patent Rule 3-1(d), which requires “an identification of any direct infringement.” Round  
17 Rock's infringement contentions required SanDisk to guess whether Round Rock sought liability on  
18 account of SanDisk selling, using, offering for sale, importing, or any combination of any of the  
19 foregoing.

20 Similarly, Round Rock's contentions failed to describe how SanDisk allegedly induced the  
21 unnamed third parties to infringe under 35 U.S.C. § 271(b), or how SanDisk contributed to their  
22 infringement under 35 U.S.C. § 271(c). For example, Round Rock did not provide any facts as to  
23 how SanDisk induces the customers to infringe. Similarly, Round Rock failed to describe how  
24 SanDisk's products are “especially made or especially adapted for use” in an infringing manner, or  
25 even what components must be combined with SanDisk's products in order to infringe the Round  
26 Rock patents under 35 U.S.C. §271(c). Round Rock's infringement contentions are insufficient  
27 under the Patent Local Rules because Round Rock's “disclosure of indirect infringement merely  
28 restates its theory of direct infringement. Such ‘generic allegations’ are insufficient to disclose a

theory of indirect infringement.” *See France Telecom*, 2013 WL 1878912 at \*5. In *France Telecom*, the court found the infringement contentions insufficient under L.R. 3-1(d) for disclosing:

Marvell has “induced and contributed to such infringement by ... designing the accused products ... managing the design ... designing and testing the accused products specifically for compatibility and use within the United States ... and advertising or representing to third parties that the infringing products are compatible or adapted for use within the United States.”

*Id.* at \*5 (alterations in original). The court found these contentions insufficient because “[w]ith the exception of its assertion that Marvell engages in advertising . . . its disclosure is a bare-boned recitation of the essential elements of a claim for indirect infringement, **and Rule 3-1(d) requires facts.**” *Id.* (emphasis added); *see also Bender*, 2010 WL 2991257, at \*4 (requiring the plaintiff to “identify how any third party was engaging in acts of direct infringement and how [the defendant] was allegedly contributing to that direct infringement.”). Indeed, Round Rock “fails to identify what advertisements and instructions lead to what infringing behavior. Although [Round Rock] is not obligated to identify the third-party infringers, it must still disclose how exactly it believes [SanDisk] indirectly or contributorily infringed [the patents]. Its boilerplate language does not suffice.” *See Creagri, Inc. v. Pinnacle Life, Inc.*, No. 11-cv-06635-LHK-PSG, 2012 WL 5389775 (N.D. Cal. Nov. 2, 2012).<sup>4</sup>

2. Round Rock’s experts describe indirect infringement theories for the first time.

Round Rock waited until its expert reports to describe the acts giving rise to the alleged indirect infringement, and to describe the role of both SanDisk and the newly identified alleged direct infringers. For example, Zeidman points to [REDACTED]

<sup>4</sup> Round Rock’s indirect infringement contentions provide *even less* of a description of SanDisk’s alleged indirectly infringing acts than the deficient contentions in *Creagri*, which provided “advising others to use the ... product in an infringing manner; advertising and promoting the use ... in an infringing manner; and distributing instructions, scientific papers, and videos that guide customers to use the ... product in an infringing manner.” [*Compare* Ex. 4 at Ex. B.]

1 [REDACTED]  
 2 [REDACTED] [Id. at 59.] He further provides previously  
 3 undisclosed theories about how the SanDisk products are “especially made or adapted to be coupled  
 4 with a host device in a way that infringes th[e] claims” and how SanDisk allegedly encourages its  
 5 customers to integrate the SanDisk products and to import the SanDisk Products. [Id. at p. 58–60.]  
 6 Round Rock’s other technical expert focuses on sales by [REDACTED]  
 7 [REDACTED]  
 8 [REDACTED] [Ex. 3 (Afromowitz Report) at 23–24.] These theories were not  
 9 described by Round Rock in its infringement contentions.

10 3. Round Rock’s disclosure of its theories for the first time in expert reports is  
 11 inexcusable.

12 Round Rock made no attempt to amend its infringement contentions to describe its theories  
 13 of indirect infringement, even though documents and testimony relied upon by Zeidman and  
 14 Afromowitz to support their assertions were provided well before the close of fact discovery. For  
 15 example, SanDisk produced its U.S. sales data to allow Round Rock to specifically identify  
 16 SanDisk’s customers, the alleged direct infringers. [See Ex. 10 (SanDisk’s 1<sup>st</sup> Supp’l Resp. to  
 17 Interrog. No. 9, dated Feb. 20, 2013) (providing sales information from 2007–2011); Ex. 11  
 18 (SanDisk’s 3<sup>rd</sup> Supp’l Resp. to Interrog. No. 9, dated May 14, 2013) (providing U.S. sales data for  
 19 years 2006–2012).] Indeed, Zeidman relies on these very spreadsheets to support his indirect  
 20 infringement assertions, stating that “SanDisk has provided spreadsheets with United States sales  
 21 data for the Accused Products.” [Ex. 1 at 55 ¶ 144.] Zeidman and Afromowitz also cite heavily  
 22 from the deposition testimony of SanDisk corporate representative Mr. Hinojos to support their  
 23 assertions, even though Mr. Hinojos was deposed back in June 2013. [Compare Ex. 1 (Zeidman  
 24 Report) at 57 ¶ 148 – 60 ¶ 153 (passim) and Ex. 3 (Afromowiz Report) at 23 ¶ 82 – 25 ¶ 86 with  
 25 Ex. 12 (Hinojos Dep. Tr.).]

26 This Motion is not the first time SanDisk raised with Round Rock the insufficiency of its  
 27 indirect infringement allegations. After SanDisk produced the documents and deposition testimony  
 28 upon which Round Rock’s experts rely, SanDisk sent multiple letters to Round Rock which

1 addressed insufficiencies in the infringement contentions. [See Ex. 13 (6/14/2013 Email from C.  
2 Ebertin to A. Modi and R. Cowell) at 1; Ex. 14 (7/23/2013 Lett. From C. Ebertin to R. Cowell) at 3  
3 (noting that “Round Rock has not specifically identified a single direct infringer that SanDisk  
4 allegedly induced to infringe, nor had Round Rock described any acts of SanDisk with regard to any  
5 particular direct infringer that allegedly induced that direct infringement.”]. Nonetheless, while  
6 Round Rock sought leave to amend its contentions to assert infringement of additional products [see  
7 Dkt. No. 186], it chose not to amend its contentions to comply with Patent Local Rule 3-1(d) and  
8 adequately disclose its theories of indirect infringement.

9 Accordingly, the portions of the Zeidman and Afromowitz Reports regarding alleged  
10 evidence of indirect infringement of the ’345, ’053, ’791, and ’893 Patents should be stricken.

### 11 **III. CONCLUSION**

12 Long before the close of fact discovery, SanDisk provided Round Rock with the materials it  
13 needed to seek leave to amend its infringement contentions to identify additional SanDisk products  
14 and describe its theories of infringement. Round Rock chose not to amend its contentions, and now  
15 seeks to add products and infringement theories through its expert reports. Round Rock should not  
16 be permitted to circumvent the Patent Local Rules—which require the parties to “crystallize their  
17 theories of the case early in the litigation and to adhere to those theories once disclosed,” *Mediatek*,  
18 2013 WL 588760, at \*1—and improperly introduce entirely new products and new theories of  
19 liability in the Zeidman, Afromowitz, and Wagner Reports at this late stage of the case.

20 SanDisk does not seek an order to strike the Zeidman, Afromowitz, and Wagner Reports in  
21 their entirety, but rather to strike the sections that go beyond specific allegations set forth in the  
22 infringement contentions. For the ’345 patent, this includes restricting Zeidman and Wagner to  
23 asserting infringement based on “SanDisk products that comply with the mDOC H3 datasheet,  
24 revisions 1.2 (Nov. 2007) & 1.3 (May 2008)” —which are the mDOC Products using the Dekel flash  
25 memory controller—and precluding them from asserting infringement by the microSD, SD, and  
26 iNAND products, which use other controllers. For the ’053 patent, SanDisk requests that Zeidman  
27 and Wagner be precluded from asserting infringement based upon the SDIN7XX and SDIN8XX  
28

1 products. Finally, SanDisk requests that Zeidman, Afromowitz, and Wagner be precluded from  
2 asserting that SanDisk induces or contributorily infringes the '053, '345, '791, and '839 patents.

3 Dated: January 9, 2014

VINSON & ELKINS LLP

4  
5 By: /s/ Chuck P. Ebertin  
Chuck P. Ebertin

6  
7 Attorneys for Plaintiff and Counterclaim  
Defendant, SANDISK CORPORATION

8  
9  
10 **CERTIFICATE OF SERVICE**

11 The undersigned certifies that on January 9, 2014, the foregoing document was filed with the  
12 Clerk of the U. S. District Court for the Northern District of California, using the court's electronic  
13 case filing system (ECF), in compliance with Civil L.R. 5-1. The ECF sends a Notice of Electronic  
14 Filing (NEF) to all parties and counsel who have appeared in this action and who have consented  
15 under Civil L.R. 5-1 to accept that NEF as service of this document.

16  
17 /s/ Chuck P. Ebertin  
18 Chuck P. Ebertin